

**Remarks**

Applicant encloses a check for the fee associated with a Request for Continued Examination and a two month extension of time. The Commissioner is authorized to charge any additional required fee or credit any overpayment to Deposit Account 20-1507. This paper is to be considered a Petition for the required extension of time, if necessary. Claims 1-4, 9, 10, and 17-30 are pending and all stand rejected. Applicant has added new claims 28 and 29. Basis for the new claims is found throughout the specification as originally filed, for example on pages 4-7.

**Rejection of claims 1-4, 9, 10, and 17-30 under 35 U.S.C. § 103(a)**

Claims 1-4, 9, 10, and 17-30 are rejected as obvious over Geaghan et al. (U.S. Pat. No. 5,790,114) in view of Kitada (Japanese Pat. Appl. No. P2000-35188). Geaghan et al. allegedly teaches a method for calibrating positions between a location sensing electronic device and an electronic device coupled to a display device or a personal computer including projecting an image on the surface of the location sensing electronic device, detecting a touch at a predefined calibration point, and calculating a relationship between the predefined calibration point by detecting the selection of an actual button on the surface of the location sensing electronic device.

Geaghan et al. is also cited as teaching a system for calibrating positions between a surface location sensing device and a display device including a location sensing electronic device having a location sensing surface and an exterior frame, wherein the location device is programmed to calibrate positions between the location sensing surface and the display. The Action further alleges that a predefined location is a projected button on the location sensing surface or is an actual button on the exterior frame. Moreover, the reference allegedly teaches a system for calibrating positions between the surface of an electronic whiteboard and the monitor of a personal computer wherein the electronic whiteboard has a touch sensitive surface and an exterior frame.

The Action acknowledges that Geaghan et al. does not teach or suggest a projection device, and a personal computer coupled to an electronic whiteboard. Kitada is cited as teaching a projection system coupled to a whiteboard and a personal computer. The Action concludes that it would have been obvious to one skilled in the art to modify Geaghan et al. with the teachings of Kitada in order to project the images that appear on the whiteboard.

Applicant respectfully traverses this rejection.

### **Relevant Law**

The United States Patent and Trademark Office (USPTO) has the burden of showing a prima facie case of obviousness. In re Bell, 991 F.2d 781, 783 (Fed. Cir. 1993). In determining obviousness, the invention must be considered as a whole, and the claims must be considered in their entirety. Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567 (Fed. Cir. 1983). A prima facie case of obviousness is established when the teachings from the prior art itself would have suggested the claimed subject matter to a person of ordinary skill in the art. In re Rhinehart, 531 F.2d 1048, 1051 (CCPA 1976). More specifically, the requirements for establishing a prima facie case of obviousness include: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

When a rejection depends on a combination of prior art references, the USPTO must show that there is some teaching, suggestion, or motivation to combine the references. In re Geiger, 815 F.2d 686, 688 (Fed. Cir. 1987). The mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). Finally, obviousness may not be established using hindsight. W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983).

### **Pending Independent Claims 1, 9, 17, and 28**

Independent claim 1 recites a method of calibrating positions between a location sensing electronic device and an electronic device coupled to a display device including projecting an image onto a surface of the location sensing electronic device, detecting a touch at a predefined point on the surface of the location sensing electronic device, and calculating a relationship between the predefined point on the surface of the location sensing electronic device and a position on the display device, wherein upon detecting the touch, the calculating step is initiated.

Claim 9 is directed to a system for calibrating positions between the surface of a location sensing electronic device and a display device of an electronic device having a location sensing electronic device including a location sensing surface, an electronic device including a display device, the electronic device in communication with a projection device and the location sensing electronic device, the projection device including means for projecting an image on the location sensing electronic device, and a calibration initiation means distant the electronic device, wherein upon activation of the calibration initiation means, positions between the surface of a location sensing electronic device and the display of an electronic device are calibrated.

Claim 17 is directed to a method of calibration including providing a location sensing device, providing an electronic device, initiating the calibration, and performing the calibration of positions between the location sensing device and the electronic device, an improvement wherein the step of initiating the calibration comprises initiating the calibration at a location distant the electronic device.

Claim 28 recites a system for calibrating positions between the surface of a whiteboard and a display device of a computer including a whiteboard including a location sensing surface, a computer including a display device, and a calibration initiation means distant the computer, wherein upon activation of the calibration initiation means, positions between the surface of the whiteboard and a display of the computer are calibrated.

**Geaghan et al.**

Geaghan et al. teaches a whiteboard coupled to a computer wherein writing on the whiteboard is displayed on a monitor coupled to the computer. The electronic whiteboard has control buttons around the outside perimeter of the whiteboard for selecting pen color, erase mode, or snapshot mode. Calibration of the writing on the whiteboard to the display monitor is initiated at the computer and utilizes a multiple touch interactive calibration process.

**Kitada**

Kitada is in Japanese and the English abstract and the figures teach an electronic whiteboard that has a sheet material for writing using a writing implement, a projector for projecting an image on the sheet material, a scanner for reading the image written on the sheet material, an output part outputting to recording paper the image read by the scanner or projected by the projector, a coordinates detecting part detecting information on the coordinates of an

index medium for indicating a position and a control part connected to a personal computer and controlling the scanner, the output part and the coordinates detecting part.

### **Analysis**

#### **The USPTO has not established a prima facie case of obviousness**

##### **1. Geaghan cannot be used as prior art under 35 U.S.C. § 103**

Applicant attaches an unexecuted Statement of Common Ownership demonstrating that at the time the invention described in the present application was made, all of the inventors were employees of MicroTouch Systems, Inc. and under an obligation to assign the invention to MicroTouch Systems, Inc. A signed copy of the Statement of Common Ownership will be submitted under separate cover. The Statement of Common Ownership also provides that MicroTouch Systems, Inc. was also the owner of U.S. Pat. No. 5,790,114 to Geaghan et al. at the time the invention described in the present application was made. The inventors of the present application and Geaghan are not identical. Therefore, in accordance with 35 U.S.C. § 103(c) Geaghan cannot preclude patentability under 35 U.S.C. § 103 because Geaghan and the presently claimed subject matter were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. As a result, Applicant respectfully requests that the rejection be withdrawn.

##### **2. Kitada does not qualify as prior art.**

In addition to the inapplicability of Geaghan, Kitada does not qualify as prior art against the present application. Kitada has a publication date of December 26, 2000, and a filing date of June 17, 1999, and is therefore prior art as of December 26, 2000. Applicant encloses a print out from the European Patent Office for this reference as Exhibit A indicating the publication date of Kitada to be December 26, 2000. The present application has a filing date of December 21, 2000, and claims benefit of priority to provisional application number 60/172,029 filed on December 23, 1999. Because Kitada published after the effective filing date of the present application, Kitada cannot be used as prior art against the present application. As acknowledged in the Office Action, Geaghan et al. does not teach all of the elements of the claimed subject matter. Therefore, because Kitada does not qualify as prior art against the present application, and because Geaghan et al. does not teach or suggest all of the elements of the claims, the claims are not obvious and the rejection should be withdrawn.

**3. Geaghan et al. does not teach all of the elements of the claimed subject matter.**

**Claim 1**

Even if Geaghan can be used against the present application, Geaghan et al. does not teach or suggest all of the elements of claim 1. For example, as acknowledged in the Office Action Geaghan et al. does not teach or suggest a projecting means. Additionally, Geaghan et al. does not teach or suggest a method of calibrating positions between a location sensing electronic device and an electronic device coupled to a display device wherein upon detecting the touch, the calculating step is initiated. The calibration process taught by Geaghan et al. is initiated at the computer connected to the whiteboard.

Although Geaghan et al. teaches control buttons on the frame of a whiteboard, the control buttons have specific functions such as: four pen color options including red, green, black, and blue; a wide erase button; a snapshot/erase all button; a narrow erase button; a print button; a snapshot button; and show board button. Nowhere does Geaghan et al. teach or suggest a button on the whiteboard for initiating calibration.

The Action provides that because Geaghan et al. shows a touch screen containing the same menu as displayed on a computer and buttons for inputting commands, it would have been obvious to a user to initiate calibration at the whiteboard itself as opposed to doing it at the computer. Applicant respectfully disagrees.

Nothing in Geaghan et al. teaches or suggests initiating calibration at the whiteboard. The mere fact that Geaghan et al. could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. Nothing in the record suggests initiating calibration at the whiteboard. Only the present application discloses initiating calibration at a whiteboard, and any suggestion to modify Geaghan et al. must come from the prior art and not Applicant's disclosure. Accordingly, Applicant respectfully submits that there is no suggestion in Geaghan et al. or any other reference indicated in the Office Action to modify Geaghan et al. to arrive at the presently claimed subject matter. In the absence of a suggestion to modify the reference, the reference cannot render the claims obvious.

**Claim 9**

Additionally, Geaghan et al. does not teach or suggest a calibration system having a calibration initiation means distant the electronic device.

**Claim 17**

Geaghan et al. does not teach or suggest a method of calibration in which the initializing calibration step includes initiating the calibration at a location distant the electronic device.

**Claim 28**

Finally, Geaghan et al. does not teach or suggest a calibration system having a calibration initiation means distant the computer, wherein upon activation of the calibration initiation means, positions between the surface of the whiteboard and a display of the computer are calibrated.

**4. Kitada does not cure the deficiencies of Geaghan et al.**

Although Kitada is not prior art with regard to the present application, even if considered as such, Kitada does not teach or suggest the deficiencies in the teachings of Geaghan et al. Because Kitada is in Japanese, Applicant assumes the Examiner is considering the figures in Kitada. Nothing in the figures of Kitada teach or suggest calibrating a whiteboard at all, and nothing in Kitada teaches or suggest initiating calibration upon detecting a touch or using a means distant from the computer. Because the combination of Geaghan et al. with Kitada does not teach or suggest all of the elements of the claims, the combination cannot render the claims obvious.

**Information Disclosure Statement**

The first Office Action, Paper No. 7, mailed on May 10, 2002, indicated that an IDS was not filed using the correct form and notes that in the future, a proper form must be used. Applicant believes that the Action references a Third-Party Submission in Published Application Under 37 C.F.R. § 1.99 filed by Katten Muchin Zavis on November 6, 2001, requesting consideration of 7 U.S. Patents. Although Applicant believes all 7 of these references were considered by the Examiner during the prosecution of the present application, Applicant encloses a PTO 1449 listing the patent references not previously identified on a PTO 892 by the Examiner. Applicant also includes an additional non-patent reference for consideration. Applicant respectfully requests that the Examiner initial and return the PTO 1449 indicating that each reference has been considered. Because the patent references have been previously submitted by a third-party, Applicant does not enclose copies of the patent references listed on the enclosed PTO 1449; however, if the Examiner requires additional copies, Applicant will gladly provide them.

### Conclusion

In light of the foregoing remarks, Applicant believes all claims are in condition for allowance and respectfully request reconsideration of all pending claims. In the event there is an issue with the present application, Applicant invites the Examiner to contact the undersigned at 404-885-3813.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Charles Vorndran", with a long horizontal flourish extending to the right.

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